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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,639	01/26/2005	Arthur H. Bunn	27726-98319	7426
23644 7590 01/21/2011 BARNES & THORNBURG LLP P.O. Box 2786 CHICAGO, IL 60690-2786				
EXAMINER				
BEKERMANN, MICHAEL				
ART UNIT		PAPER NUMBER		
3622				
NOTIFICATION DATE		DELIVERY MODE		
01/21/2011		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patent-ch@btlaw.com

# Office Action Summary

**Application No.**

10/522,639

**Applicant(s)**

BUNN, ARTHUR H.

**Examiner**

MICHAEL BEKERMAN

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 13-26, 29, 30 and 33 is/are pending in the application.
- 4a) Of the above claim(s) 7, 8, 14-17, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 13, 18-26 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 7, 8, 14-17, 29, and 30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 11/24/2010.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-6, 13, 18-26, and 33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claims 1-6, 13, and 18-26**, based on Supreme Court precedent, a method/process claim must **(1)** be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or **(2)** transform a particular article to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method or process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus)

nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

**Regarding claim 33**, as best understood, this claim appears to be programming (or possibly merely data) per se, and is not statutory. MPEP 2106.01 describes why a claim to functional descriptive material is non-statutory. This claim sets forth a computer software product without any mention of a non-transitory computer readable medium. Therefore, the computer software product appears to be nothing more than programming instructions that are not clearly embodied on a computer readable medium. Please reference MPEP 2106.01 for the basis of this rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4, 13, 22, 23, 26, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (U.S. Patent No. 6,249,772).** Walker discloses a system and method of providing a benefit to a second entity in a purchase transaction that includes all of the limitations recited in the above claims.

**Regarding claims 1, 22, 23, 26, and 33**, Walker teaches allowing a user to conduct a transaction via a website by selecting an item for purchase (Column 10 Lines

10-23), selecting a retailer from a list of retailers (Column 9 Line 52 – Column 10 Line 23), and compensating the user and the retailer (Column 4 Lines 52-64, retailer is compensated through increased sales and moving of inventory, user is compensated with a winning prize of lower competitive pricing).

**Regarding claims 2 and 3**, Walker teaches purchases made at the store (after a selection is finalized) or purchases made online (before the selection is finalized) (Column 10, Lines 10-34)

**Regarding claim 4**, Walker teaches an equitable selection method based on geographic preference (Column 9 Line 57 – Column 10 Line 9).

**Regarding claim 13**, Walker teaches that the retailer's profit margin remains the same (Column 4 Lines 52-64), and therefore if the manufacturer gives a lower price to a consumer, then the retailer's unit cost for that item is lowered in order to maintain the profit margin.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (U.S. Patent No. 6,249,772) in view of Meisel (U.S. Pub No. 2003/0033292).**

**Regarding claims 5 and 6**, Walker does not appear to specify selecting a portion of entities to display based on the entities that provide the manufacturer the most revenue. Meisel, however, discloses a search engine that displays a select number of advertisements (time-convenient) for retailers on a webpage that are selected based on which retailers generate the most revenue for the search engine, and the system updates on a cyclical basis to reassess which retailers still provide the most revenue (Abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to select entities to display that purchase a greater value of products from the manufacturer, as this will entice other retailers to purchase a greater value of products as well.

5. **Claims 18-21, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (U.S. Patent No. 6,249,772).**

**Regarding claims 18-21**, Walker does not appear to specify monitoring for abuse or administering punishment for abuse of the system. However, users have been abusing and taking advantage of 3<sup>rd</sup> party programs and systems for years (in the instant case of Walker, should retailers constantly agree to a price and go back on it later, or should retailers confirm that an item is in stock only to sell it to another customer later, such retailers would become burdens on the system). Techniques for

monitoring such abuses are old and well-known. Franchise owners will typically receive inspections from corporate to make sure they are up to current looks and standards. Further, department stores such as Belk and J.C. Penney will receive inspections from manufacturers (such as Tommy Hilfiger or Ralph Lauren) to ensure that merchandise is being displayed properly according to pre-established agreements. Should franchise owners break the rules, they lose their franchises, and should department stores break agreements with designers, they risk losing the ability to carry that line of clothing. Another example would be North Carolina grocery stores selling liquor, in which the selling of liquor to a minor would break the agreement between the grocery store and the state of North Carolina, thus resulting in the loss of a liquor license. Walker already teaches that retailers benefit from the system (Column 4 Lines 52-64), so it would have been obvious to one having ordinary skill in the art at the time the invention was made to monitor the system to make sure retailers weren't abusing it, and to remove any problem retailers from the system (thereby reducing a benefit to that retailer) in order to keep the entire system respectable and running smoothly.

**Regarding claims 24 and 25,** Walker does not appear to specify entering a user into a contest, or providing a user with a credit for a future purchase. However, the act of providing those types of rewards to influence the attendance of users in a system is old and well-known. Pepsi and Coca Cola generally offer the opportunity to win big prizes by using their particular beverage. Fast food chains such as Taco Bell or McDonalds provide contents in which users may win prizes by spending money at that particular establishment. Further, coupons that are good towards a credit on a future

purchase are user by grocery stores for purchases made at those grocery stores, particularly Food Lion or Harris Teeter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to entice users to use the manufacturer pricing system of Walker by providing these, or any such rewards to users. This will draw more users to the system, thus making the manufacturer and retailers more successful.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Thursday, 9:00 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Bekerman/  
Primary Examiner, Art Unit 3622